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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/071,238  | 02/11/2002  | Hans-Jurgen Brehm    | MERCK-2387          | 9123             |
| 23599   | 7590        | 03/15/2004           | EXAMINER            |                  |
| MILLEN, WHITE, ZELANO & BRANIGAN, P.C.<br>2200 CLARENDON BLVD.<br>SUITE 1400<br>ARLINGTON, VA 22201 |             |                      | SHOSHO, CALLIE E    |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1714                |                  |

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/071,238

Applicant(s)

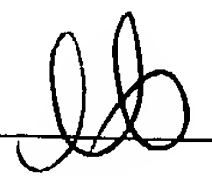
BREHM ET AL.

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-9 and 11-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-9 and 11-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. All outstanding rejections are overcome by applicants' amendment filed 12/19/03.

The following action is non-final in light of the use of a new reference against the present claims, namely, GB 1587894, found upon updating the searches.

**Claim Rejections - 35 USC § 102**

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 3-5, 8-9, 11, and 13-23 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 1587894.

GB 1587894 disclose plastic part, i.e. molded article, comprising thermoplastic polymer such as polybutylene terephthalate, assistant for plastic processing, 5-59% platelet filler such as talc, kaolin, mica, and glass platelets that have diameter of tens of microns, and glass beads possessing diameter of 6-66  $\mu\text{m}$ . The glass beads are present in amount of, for instance, 10%. There is also disclosed a process for preparing the plastic part by incorporating into the plastic the platelet filler and glass bead and forming the plastic part by molding (pages 1, lines 5-6 and 36-40, page 2, lines 8-12 and 28-33, page 2, line 65-page 3, line 3, page 3, lines 14-15 and 19-22, and example 5).

Although there is no disclosure that the alignment of the platelets is other than substantially parallel with the surface of the plastic part, given that the platelet filler is mixed with filler identical to that presently claimed whose presence would affect the alignment of the

pigment, it is clear that the alignment of the platelet would inherently be other than substantially parallel with the surface.

Further, although there is no disclosure that the plastic part exhibits pronounced glitter effect, given that GB 1587894 et al. disclose pigment, i.e. platelet-shaped talc, kaolin, mica, and glass, and filler identical to that presently claimed, it is clear that the plastic part would inherently possess glitter effect as presently claimed.

In light of the above, it is clear that GB 1587894 anticipates the present claims.

**Claim Rejections - 35 USC § 103**

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1587894.

The disclosure with respect to GB 1587894 in paragraph 3 above is incorporated here by reference.

The difference between GB 1587894 and the present claimed invention is the requirement in the claims of amount of glass bead.

The only disclosure in GB 1587894 regarding the amount of glass beads found in the plastic part is found in the examples. It is disclosed that the plastic part comprises, for instance, 10% glass bead. However, such amount falls outside the scope of present claims 7 and 12.

However, the examples are but a few preferred embodiments of GB 1587894. A fair reading of the reference as a whole discloses that the glass beads are used to reduce the amount of platelet filler used and to improve electroconductivity, flame retardance, and frictional properties (page 3, lines 5-8). Thus, it would have been within the skill level of one of ordinary skill in the art to recognize that controlling the amount of glass beads would control the properties of the plastic part.

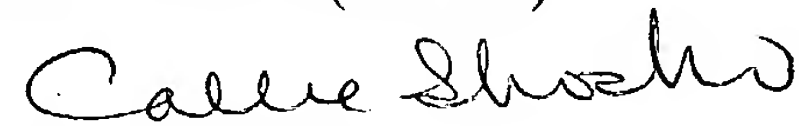
In light of the above, it therefore would have been obvious to one of ordinary skill in the art to choose amounts of glass beads, including that presently claimed, in order to control the amount of platelet filler used and to produce plastic part with the desired electroconductivity, flame retardance, and frictional properties, and thereby arrive at the claimed invention.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho  
Primary Examiner  
Art Unit 1714

CS  
3/6/04